

Claims 1-8 have been rejected under 35 USC 102(a) and 35 USC 102(e) as anticipated by Pegg 6,634,956. The rejection is respectfully traversed.

It should first be noted that Pegg '956 cannot technically be applied against this application under Sec. 102(e) since the applicant in the present application is the inventor named in Pegg '956. 35 USC 102(e) requires that the invention be described in an application for patent *filed by another* or a patent issued on an application *filed by another*.

This rejection under 35 USC 102(a) is also inapposite. An anticipation rejection requires disclosure in a single prior art reference of each and every element of the claimed invention arranged as in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. U.S. Int. Trade Comm'n*, 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 1730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). In order to support an anticipation rejection under §102(a) it is also necessary that the prior art reference teach in a single structural combination all elements of the invention and the elements must perform substantially the same work the same way in both the prior art reference and the claimed invention. *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 145 USPQ 6 (10th Cir. 1985).

In rejecting Claims 1 and 6, the Examiner alleges:

“...Pegg discloses a putter comprising: (a) a putter head having a first mass and defining a bottom face, a top face and a striking face which defines a horizontal axis and which extends in a substantially vertical plane from said bottom face toward said top face and extends at least about four inches in a plane substantially parallel with said horizontal axis to inherently define a preferred striking area approximately centrally located on said striking face and extending a distance of approximately one inch in each direction horizontally from the horizontal mid-point of said striking face; and (b) a shaft having a second mass and extending from the top face of said putter at an angle of from about 10° to about 25° from vertical with respect to said horizontal axis supporting a grip on the end thereof remote from said putter head and aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area (See Figures 1 and 2 and Column 2, lines 53 through 59).”

The Examiner, however, is in error.

Claim 1 specifically requires the shaft and grip to be “aligned so that the vertical center of mass of the putter lies within the horizontal length of said preferred striking area.” No such arrangement is shown or even remotely suggested in Pegg ’956. Apparently, the Examiner has confused (and attempted to equate) “free standing” as disclosed in Pegg ’956 with “vertically mass balanced” as disclosed and claimed in the present application. Pegg ’956 discloses and claims a free standing putter in which specific parameters such as mass and shape of the putter head are specifically defined. The specific parameters defined are necessary in order to permit the putter to be free standing regardless of the location of its vertical center of mass. In contradistinction, Claim 1 specifically defines the relationship between the putter head and the shaft as “aligned so that the vertical center of mass lies within the horizontal length of said preferred striking area.” The “vertical center of mass” and “preferred striking area,” as used in Claim 1, are neither defined, disclosed nor recognized in Pegg ’956. Accordingly, nothing in the disclosure of Pegg ’956 can be used to support an anticipation rejection of Claim 1 and the rejection should be withdrawn.

In addition to the specific requirement that the putter head and shaft be arranged and weighted “to align the vertical center of mass thereof within the horizontal length of said striking area” (as in Claim 1), Claim 6 further requires

“(b) a shaft extending from said top face of said putter at a position between said horizontal midpoint and said toe...”

No such specific structure is shown or even remotely suggested in Pegg ’956. Instead, Fig. 2 of Pegg ’956 (relied on by the Examiner) shows the shaft extending from the top of the putter head between the horizontal midpoint of the putter head and the heel of the putter head. Accordingly, the rejection of Claim 6 is clearly inapposite and must be withdrawn.

In rejecting Claim 2, the Examiner alleges:

“Pegg shows the putter head being geometrically symmetrical about its vertical axis (see Figure 2).”

Admittedly, Fig. 2 of Pegg '956 shows a putter head symmetrical about its vertical axis. However, Claim 2 is dependent from Claim 1 and thus includes all the limitations of Claim 1. Since Pegg '956 fails to show or remotely suggest the limitations of Claim 1 (from which Claim 2 depends) as demonstrated hereinabove, the rejection of Claim 2 is inapposite for the reasons stated above with respect to the rejection of Claim 1.

In rejecting Claim 3, the Examiner alleges:

“Pegg shows the shaft extending from the top face at a point between the toe end of the putter head and the vertical axis of the putterhead (See Figure 2).”

As noted above, the Examiner is in error. Fig. 2 of Pegg '956 clearly shows shaft 30 extending from the top face 13 of the putter head at a point between the vertical axis of the putter head and the heel of the putter head as in conventional putters and *opposite* the location specified in Claim 3. Furthermore, Claim 3 is ultimately dependent from Claim 1 and thus is also patentable over Pegg '956 for the reasons set forth hereinabove with respect to Claim 1. Accordingly, the rejection of Claim 2 is likewise inapposite and must be withdrawn.

In rejecting Claim 4 and Claim 7, the Examiner alleges:

“Pegg shows the putter head including a marker on the top face thereof which identifies the horizontal midpoint of the striking face (See Figure 2).”

Admittedly, Fig. 2 of Pegg '956 illustrates a marker on the top face of the putter head which identifies the horizontal midpoint of the striking face. However, Claim 4 is dependent from Claims 3, 2 and 1 and thus includes all the limitations of Claims 1, 2 and 3. Since Pegg '956 fails to show or remotely suggest the limitations of Claims 1, 2 or 3 as demonstrated hereinabove, the rejection of Claim 4 is inapposite for the same reasons.

With regard to Claim 7, the Examiner is again mistaken. Claim 7 is dependent from Claim 6 and thus includes all the limitations of Claim 6. The rejection of Claim 7 is therefore inapposite for the reasons set forth hereinabove with respect to Claim 6.

In rejecting Claim 5 the Examiner alleges:

“Pegg shows the mark extending in opposite directions from the geometric center of the putter head (See Figure 2).”

Applicant fails to comprehend the significance of this comment. Claim 5 is dependent from Claim 4 which includes all the limitations of Claims 3, 2 and 1 from which it ultimately depends. Since the sole reference cited fails to disclose the specific limitations of Claims 1, 2, 3 and 4, all as set forth hereinabove, that same reference is wholly incapable of showing or suggesting the limitations of Claim 5.

In rejecting Claim 8 the Examiner alleges:

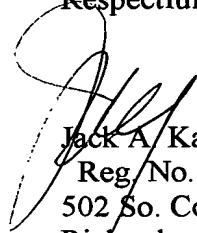
“Pegg shows the marker equally visible on the opposite sides of the shaft when the marker is aligned for striking a ball and the striking face is aligned perpendicular to the desired direction of travel of the ball (See Figure 2).”

Again, the Examiner is in error. Fig. 2 of Pegg '956 clearly shows the shaft 30 between the heel and the horizontal midpoint of the putter head. Since the shaft is also inclined toward the heel, the marker 16 identifies only the horizontal midpoint of the putter head. The horizontal center of mass, however, is at an undetermined point between marker 16 and the heel of the putter head because the entire mass of the shaft 30 and grip 31 are displaced on the heel side of marker 16. Furthermore, Claim 8 is dependent from Claim 7 which, in turn, is dependent from Claim 6 and therefore includes all the limitations of Claims 6 and 7. Accordingly, Claim 8 is further patentable over the same reference for the reasons set forth hereinabove with respect to Claims 6 and 7.

Since Applicant has demonstrated that each of Claims 1-8 is patentable over the sole reference cited thereagainst, it is respectfully requested that the rejection of Claims 1-8 be withdrawn and the case passed to issue. An early action to that effect is earnestly solicited.

In the event a telephone conference could resolve any outstanding issue, a call to the undersigned is invited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jack A. Kanz', is written over the typed name and address.

Jack A. Kanz
Reg. No. 23, 061
502 So. Cottonwood Dr.
Richardson, Texas 75080
Tel 972.234.1394
Fax 972.234.5171

December 20, 2004

ATTORNEY FOR APPLICANT